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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,587	10/23/2001	Seiya Motomiya	6667/24 (LTC-16-US)	6477

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EXAMINER
EGAN, BRIAN P

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/037,587	Applicant(s) MOTOMIYA, SEIYA
	Examiner Brian P. Egan	Art Unit 1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 6-9, 13-14, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (#5,885,677) in view of Yamane (#5,489,359) or JP 09-175051 (hereinafter JP '051).

Gosselin et al. disclose a pressure sensitive adhesive label for indicating information (see Abstract; Col. 2, lines 54-55), the pressure sensitive adhesive label constructed such that it is stuck onto a release sheet with a printed layer before the pressure sensitive adhesive label is used (Col. 2, lines 31-37). The label comprises a release sheet with a release sheet base (Col. 4, lines 44-46), a releasing agent layer provided on one of the surfaces of the release sheet base (Col. 4, lines 46-47), and a printed layer provided on the releasing agent layer wherein the printed layer has fixed and/or variable information and is formed via thermal transfer printing ("barrier medium"; Col. 5, lines 36-46; Col. 6, lines 40-43). The label further comprises a label base (Col. 1, lines 55-56; Fig. 1, #21) and a pressure sensitive adhesive layer provided on one of the surface of the label base (Col. 1, lines 56-57; Fig. 1, #26). The printing layer on the release sheet faces the pressure sensitive adhesive layer (see Fig. 1, #s 22 and 26). The pressure sensitive adhesive layer contains a fluorescent dye (Col. 4, lines 59-60). Gosselin et al. further disclose a method of making the pressure sensitive adhesive label wherein a release sheet is prepared with a releasing

agent layer and subsequently printed with a printing layer via thermal transfer printing (Col. 5, lines 54-56). A pressure sensitive adhesive label is then prepared and stuck onto the releasing agent layer of the release sheet such that the printed layer faces the pressure sensitive adhesive layer (Col. 5, lines 47-51 and 56-58). Ultimately, the pressure sensitive adhesive label is removed from the release sheet and transferred to a substrate (Col. 5, lines 59-62).

Although Gosselin et al. teach that a wide variety of release liners may be used (Col. 4, lines 44-45), Gosselin et al. explicitly teaches only silicone-based release materials, thereby failing to teach non-silicone containing release materials. It is notoriously well known in the art, however, to select non-silicone containing release materials in the thermal transfer printing art depending on the desired end product as evidenced by both Yamane and JP '051. Yamane teaches that silicone resin, fluoro resin, polyolefin resin, and paraffin resin are functionally equivalent release agents for a thermal transfer printed base layer (Col. 6, lines 32-35; Col. 13, lines 50-60). JP '051 teach the use of a non-silicone containing release agent for the purpose of providing optimal printed image formation and improved scratch resistance (see Abstract) and teaches that the release agents may be selected from urethane resin, fluororesin, acrylic resin, olefin resin, and stearate release agents (see translation, paragraph [0016]). Thus, it would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have used a non-silicone containing release agent in a thermal transfer printed product for the purpose of providing a functionally equivalent release agent to that of a silicone containing release agent or to provide optimal printed image formation and improved scratch resistance as taught by both Yamane and JP '051, respectively.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Gosselin et al. by selecting a non-silicone containing release layer as taught by both Yamane and JP '051 in order to provide a functionally equivalent release agent to that of a silicone containing release agent or to provide optimal printed image formation and improved scratch resistance. Furthermore, even in the absence of the teachings of either Yamane or JP '051, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have selected a non-silicone containing release agent for the release layer in Gosselin et al. since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious optimization absent demonstration of unexpected results. *In re Leshin*, 125 USPQ 416.

3. Claims 10-11, 15-16, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (#5,885,677) in view of Yamane (#5,489,359) or JP '051, and further in view of Higgins (#5,932,352).

Gosselin et al., Yamane, and JP '051 teach a pressure sensitive adhesive label as detailed above. The aforementioned prior art is silent as to whether the label base is formed of transparent or non-transparent material. It is notoriously well known in the art, however, to select either a transparent or non-transparent material for the label base depending on the desired end product as evidenced by Higgins (Col. 3, lines 21-54). Thus, depending on the desired end product, it would have been obvious to have modified the aforementioned prior art to include either a transparent or non-transparent base. Furthermore, even in the absence of the teachings of Higgins, it would have been obvious to one of ordinary skill in the art at the time Applicant's

invention was made to have selected either a transparent or non-transparent base material in the aforementioned prior art since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious optimization absent demonstration of unexpected results. *In re Leshin*, 125 USPQ 416.

4. Claims 12, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (#5,885,677) in view of Yamane (#5,489,359) or JP '051, and further in view of the Applicant's admitted prior art (see Specification, p.12).

Gosselin et al., Yamane, and JP '051 teach a pressure sensitive adhesive label as detailed above. The aforementioned prior art fails to teach the printing layer to include a metallic layer.

The Applicant's admission, however, explicitly states that printing films comprising metallic layers are well known in the art and state that Murata Kimpaku Co., Ltd. of Japan provide a printing film encompassing the desired properties (see p. 12). The metallic printing layer is used for the purpose of providing the label with a printing layer that is easily transferable between the release liner and the adhesive when the adhesive is removed from the release liner (see p. 12). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time Applicant's invention was made to have modified a printing layer in a security label to include a metallic layer for the purpose of providing the label with a printing layer that is easily transferable between the release liner and the adhesive as disclosed by the Applicant.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified the aforementioned prior art to include a notoriously well known metal printing film such as the one sold by Murata Kimpaku Co., Ltd. in

order to provide a label with a printing layer that is easily transferable between the release liner and the adhesive. Gosselin et al. provide motivation towards making such a modification since Gosselin et al. teach that the printing layer ("barrier medium") is to be selected such that the printing layer has a lower adhesion to the release liner than the adhesive layer (Col. 4, lines 47-50).

5. Claims 12, 17, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (#5,885,677) in view of Yamane (#5,489,359) or JP '051, and further in view of Yamano et al. (#4,775,786).

Gosselin et al., Yamane, and JP '051 teach a pressure sensitive adhesive label as detailed above. The aforementioned prior art fails to teach the use of a metallic layer in the printed layer.

Yamano et al., however, teach the use of a metallic layer in a pressure sensitive adhesive label printing layer (Col. 2, lines 19-25) wherein the label is printed via transfer printing (Col. 2, lines 41-44). Yamano et al. teach the use of metallic layers in a pressure sensitive adhesive label for the purpose of providing a barcode that comprises a color that contrasts sharply from the color of the substrate (Col. 2, lines 32-39) and to provide a barcode that is excellent in high-temperature durability and chemical resistance (Col. 1, lines 46-54). It would have been obvious through routine experimentation to one of ordinary skill in the art at the time applicants invention was made to have modified a barcode to include a metallic printing layer for the purpose of providing a barcode that comprises a color that contrasts sharply from the color of the substrate and to provide a barcode that is excellent in high-temperature durability and chemical resistance as taught by Yamano et al.

Therefore, it would have been obvious to one of ordinary skill in the art at the time applicants invention was made to have modified the aforementioned prior art, motivated by the fact that the printing layer of Gosselin et al. is a barcode in some embodiments (Col. 2, lines 54-55), to include a metallic layer within the printing layer as taught by Yamano et al. in order to provide a barcode that comprises a color that contrasts sharply from the color of the substrate and to provide a barcode that is excellent in high temperature durability and chemical resistance.

Response to Remarks

6. The 35 U.S.C. 112, second paragraph rejections from the previous office action have been withdrawn by the Examiner pursuant to the Applicant's amended claims.

7. Applicant's arguments with respect to newly added claims 6-22 and the 35 U.S.C. 102(b) and 103(a) rejections from the previous office action have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

BPE
May 20, 2003

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/28/03